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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/341,539	10/12/1999	JEAN-PHILIPPE DESLYS	045636-5027	5256

9629 7590 10/10/2002

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EXAMINER

PARKIN, JEFFREY S

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 10/10/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/341,539

Applicant(s)

DESLYS ET AL.

Examiner

Jeffrey S. Parkin, Ph.D.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Office Action

Status of the Claims

1. Applicants' election with traverse of Group II (claims 7-13) in paper no. 10 is acknowledged. The traversal is based upon the premise that the claimed inventions share a common technical feature. This is not found persuasive for the reasons of record previously set forth in paper no. 7. Applicants were previously advised that:

The inventions listed as Groups I-III do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: First, each of the identified groups is directed toward a different methodology (e.g., therapeutic screening assay, protein purification assay, detection/diagnostic assay) that employs fundamentally different scientific reagents and methodology steps. Second, the claimed invention fails to make a contribution over the prior art (i.e., see the ISA Chapter I search report). Thus, the identified groups lack a special technical feature and do not form a single inventive concept as required under PCT Rule 13.1.

Accordingly, the requirement is still deemed to be proper and is therefore made FINAL. Claims 1-6, 14, and 15 are withdrawn from further consideration by the examiner, pursuant to 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. Claims 7-13 are currently under examination.

Information Disclosure Statement

2. The information disclosure statement filed 12 October, 1999, has been placed in the application file and the information referred to therein has been considered.

35 U.S.C. § 103(a)

3. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office

action:

5 (a) A patent may not be obtained though the invention is not
identically disclosed or described as set forth in section 102 of
this title, if the differences between the subject matter sought to
be patented and the prior art are such that the subject matter as
a whole would have been obvious at the time the invention was made
to a person having ordinary skill in the art to which said subject
matter pertains. Patentability shall not be negated by the manner
in which the invention was made.

10 Subject matter developed by another person, which qualifies as
prior art only under subsection (f) or (g) of section 102 of this
title, shall not preclude patentability under this section where the
subject matter and the claimed invention were, at the time the
15 invention was made, owned by the same person or subject to an
obligation of assignment to the same person.

4. This application currently names joint inventors. In
considering patentability of the claims under 35 U.S.C. § 103(a),
20 the examiner presumes that the subject matter of the various claims
was commonly owned at the time any inventions covered therein were
made absent any evidence to the contrary. Applicant is advised of
the obligation under 37 C.F.R. § 1.56 to point out the inventor and
invention dates of each claim that was not commonly owned at the
25 time a later invention was made in order for the examiner to
consider the applicability of 35 U.S.C. § 103(c) and potential 35
U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

5. Claims 7-13 are rejected under 35 U.S.C. § 103(a) as being
30 unpatentable over McKenzie et al. (1994). McKenzie and colleagues
provide methods for the isolation and purification of PrP-res.
Although this teaching does not disclose every single purification
step, nevertheless, all those steps employed are well-known in the
art and would only require routine experimentation.

35 6. Claims 7-13 are rejected under 35 U.S.C. § 103(a) as being
unpatentable over Prusiner et al. (1998). McKenzie and colleagues
provide methods for the isolation and purification of PrP-res.
Although this teaching does not disclose every single purification

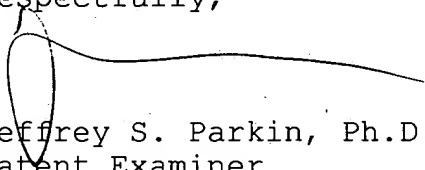
step, nevertheless, all those steps employed are well-known in the art and would only require routine experimentation.

Correspondence

5 7. Correspondence related to this application may be submitted to
Group 1600 by facsimile transmission. The faxing of such papers
must conform with the notice published in the Official Gazette,
1096 OG 30 (November 15, 1989). Official communications should be
directed toward one of the following Group 1600 fax numbers: (703)
10 308-4242 or (703) 305-3014. Informal communications may be
submitted directly to the Examiner through the following fax
number: (703) 308-4426. Applicants are encouraged to notify the
Examiner prior to the submission of such documents to facilitate
their expeditious processing and entry.

15 8. Any inquiry concerning this communication should be directed to
Jeffrey S. Parkin, Ph.D., whose telephone number is (703) 308-2227.
The examiner can normally be reached Monday through Thursday from
8:30 AM to 6:00 PM. A message may be left on the examiner's voice
20 mail service. If attempts to reach the examiner are unsuccessful,
the examiner's supervisors, James Housel or Laurie Scheiner, can be
reached at (703) 308-4027 or (703) 308-1122, respectively. Any
inquiry of a general nature or relating to the status of this
application should be directed to the Group 1600 receptionist whose
25 telephone number is (703) 308-0196.

Respectfully,


Jeffrey S. Parkin, Ph.D.
Patent Examiner
Art Unit 1648

30 September, 2002